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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,210	12/13/2001	Stephen C. Goss	20-4-12	1204
7590	04/07/2005		EXAMINER	
Werner Ulrich 434 Maple Street Glen Ellyn, IL 60137-3826			FOSTER, ROLAND G	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/017,210	GOSS ET AL.
	Examiner Roland G. Foster	Art Unit 2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 October 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-5,7-9,11-13,15 and 16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3-5,7-9,11-13,15 and 16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-5, 7-9, 11-13, 15, and 16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-5, 7-9, 11-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,829,554 ("Barnes"), newly cited.

With respect to claims 1 and 5, see the following paragraphs for details on how Barnes teaches the claim limitations.

The limitation "[i]n a switching system for serving wireless customers, apparatus for temporarily suspending a connection from one leg of a conference connection" reads on Barnes as follows. A cellular mobile telephone switching system (abstract and Fig. 1) comprises a central control station 20 (apparatus). The central control station 20 includes a conference bridge (Fig. 4). The conference bridge establishes internal conference legs connections to multiple wireless and/or wireline telephones (Fig. 14B) (see also col. 13, lines 23-59). During the process of adding conference participants, the some telephones are temporarily suspended from the conference leg while additional parties are dialed and added (col. 29, lines 30-39 and col. 51, line 65 – col. 52 , line 5).

The limitation "means for temporarily disconnecting a mobile station connected to said leg, which sends a special indication, in response to receipt of said special indication" reads on Barnes as follows. During an ongoing telephone call, the user at the mobile station requests additional services by depressing one or more keys that cause the mobile station to send special out-of-band data signals (special indications) to be received at the central control station 20 (col. 51, lines 11-41). The additional services include conferencing and call consultation hold (col. 51, lines 11-21 and lines 49-57).

Barnes fails to specifically disclose that the user requests the call consultation hold service after the call conferencing service. However, Barnes provides the ability to trigger these additional services by simply pressing a key as discussed above.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to request the call consultation hold service after the call conferencing service as taught by Barnes.

The suggestion/motivation for doing so would have been to use the mobile station of Barnes in the manner intended and designed for, specifically to easily request a plurality of services by entering the appropriate key commands. As to why the user would have wanted to request a consultation call after a conference, the ability to make a consultation call increases the user-friendliness and flexibility of the mobile terminal service by allowing the user, who is engaged in a conversation (whether a regular two-party call or a conference), the capability to consult with other persons (as the name of the service implies). Further, Barnes provides the capability (i.e., no structural modification is required) for the user to request the additional services in any order by pressing the appropriate keys. Thus, the modification involves only intended use. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this way, owners of the patented prior art devices are protected when using their devices as they see fit in a normal manner without structural modification.

Thus, Barnes as modified teaches of call consultation hold feature, where the central control station mobile station toggles (temporarily disconnects) a mobile (cellular) telephone from the ongoing call (conference) (col. 51, lines 49-57), which involves the user's conference call leg as discussed above, in response to the receipt of special indication sent by the mobile terminal.

The limitation "means for making a record in said switching system of a port to which said leg was connected" reads on Barnes (as modified) as follows. The central control station 20 comprises multiple circuits such as trunks 24 and subscriber lines 106a-n and multiple electronic devices such as trunk interface 100, telephony devices 104a-n, switch matrix 102a,b and conference bridge (Fig. 4), which therefore require "ports" (i.e., physical or electrical interfaces through which one gains access or physical interfaces between devices and circuits). For example, the conference bridge comprises input/output ports (col. 13, lines 35-41). Barnes inherently requires a record to be kept within the switching system of which ports the ongoing call was connected to as the user toggles back and forth between the ongoing call (conference call) and the consultation call (as discussed above). Otherwise, the switching system would be randomly reconnecting the user to ports as the user toggled back and forth, which would render the consultation hold feature inoperative for its intended purpose.

The remaining limitations are clearly disclosed by Barnes as modified in view of the discussion above.

Claims 9 and 13 differ substantively from claims 1 and 5 in that claims 9 and 13 recite a method comprising steps equivalent to the functions performed by the means of claims 1 and 5. Therefore, see the claims 1 and 5 rejections for further details.

With respect to claims 3, 4, 7, 8, 11, 12, 15, and 16, Barnes discloses that special the indication and reconnect request uses keys on the mobile station keyboard but fails to specifically disclose that the indication and request include keyed characters that are identical or that the indication terminates with a send code.

However, "Official Notice" was taken that both the concept and advantages of transmitting an on hook/off hook sequence using keyed characters including pressing the same (identical) "send key" and to terminal special dialed code features also by pressing the "send" key would have been well known and expected in the art of wireless telephones. The applicant's lack of traverse to the officially noticed fact in the last Office action is taken as an admission of the facts noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add to the special indication and reconnect request commands as disclosed by Barnes the use of the same (identical) "send" key to indicate on hook/off hook and to terminate special dialed codes.

The suggestion/motivation for doing so would have been to conform to wireless telephone industry standards and to increase operational efficiency where the send key is commonly and efficiently used to signal on hook/off hook and to terminate dialing sequences.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (571) 272-7538. The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster  
Primary Patent Examiner  
April 1, 2005